UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,437	05/04/2001	Tim W. Blair	2222.038000H	7818

26111   7590   11/15/2006

STERNE, KESSLER, GOLDSTEIN & FOX PLLC
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER
PHAM, KHANH B

ART UNIT	PAPER NUMBER
2166	

DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/848,437	BLAIR ET AL.
	Examiner	Art Unit	
	Khanh B. Pham	2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>29 September 2006</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-90* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-90* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

    1.☐ Certified copies of the priority documents have been received.

    2.☐ Certified copies of the priority documents have been received in Application No. _____.

    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114.

2.   Applicant's submission filed on September 29, 2006 has been entered. Claims

21, 35, 49, 63, and 77 have been amended. Claims 21-90 are pending in this Office

Action.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

Claims 77-90 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter.

Claims 77-90 recite "a device" but none of the elements of the claimed device

necessarily implemented in hardware. The claimed devices comprise only logic and are

directed to an arrangement of software, per se, Claims 77-90 are therefore rejected as

not being tangible.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   **Claims 21-90** are rejected under 35 U.S.C. 102(e) as being anticipated by Unger

(US 5,721,910 A), hereinafter "Unger".

As per claim 21, Unger teaches a method of enabling a user to organize and

analyze information comprising:

- "searching an input first group of documents to output a second group of

    documents" at Col. 3 lines 8-20;

(Unger teaches the step of using predefined search criteria to

disaggregate a set of documents into discrete technical

categories (i.e., "second group"))

- "analyzing an input third group of documents according to one or more analytical

    functions to output a fourth group of documents" at Col. 6 lines 25-55.

(Unger teaches the stored analysis may be used to analyze

documents and identify a set of documents of particular interest

for a particular application)

- "selectively iterating at least one of the searching and at least one of the

    analyzing, wherein each iteration of the searching or the analyzing is performed

    using as the input one of the second group, the fourth group, or the output of a

    previous iteration" at Col. 3 lines 55-59 and Col. 6 lines 25-55.

(Unger teaches the step of further searching one or more

categories (i.e., "second group") to identify a subset of

documents. Unger also teaches the set of analyzed patents and/or

technical documents (i.e., "fourth group") may then be used to

identify trends(i.e., analyzing);

- "wherein said selectively iterating includes performing an additional iteration of

    the searching using the fourth group as input, to output a fifth group of

    documents" at Col. 6 lines 45-55.

(Unger teaches the step of using "patent numbers for this set of

patents" (i.e., "the fourth group") as unique identifiers to

search and display the full text and associated graphic

images(i.e., "output a fifth group of document".)

As per claim 22, Unger teaches the method of claim 21, further comprising:

"making at least one of the second group or the fourth group a permanent group" at Col.

3lines 45-50.

As per claim 23, Unger teaches the method of claim 21, wherein the searching

comprises: "performing a cluster analysis of the first group of documents to create a

hierarchical arrangement of groups containing documents from the first group, wherein

the second group is one of the hierarchical arrangement of groups" at Col. 5 lines 35-

63.

As per claim 24, Unger teaches the method of claim 21, further comprise

"performing a relevancy visualization analysis of one of the first group and the third

group to identify how documents contained therein are inter-related with respect to key

terms" at Col. 7 lines 5-25.

As per claim 25, Unger teaches the method of claim 24, wherein "relevancy

visualization analysis operates according to a rule book" at Col. 5 lines 15-35.

As per claim 26, Unger teaches the method of claim 25, wherein the rule book

comprises patent specific rule" at Col. 5 lines 15-35.

As per claim 27, Unger teaches the method of claim 21, further comprising:

"generating an object corresponding to a search process component or an analyze

process component of a work flow represented by the searching, the analyzing, and

selective iterating" at Col. 7 line 25 to Col. 8 line 50.

As per claim 28, Unger teaches the method of claim 27, wherein an object is

generated using object definition" at Col. 8 lines 35-50.

As per claim 29, Unger teaches the method of claim 28, wherein the object

definition comprise: "a Boolean operation object definition, a corporate family operating

object definition; an export object definition; a folder object definition; an import object

definition; a list exploder operation object definition; a list object definition; a query

object definition; or a patent family dedupe object definition" at Col. 8 lines 35-50.

As per claim 30, teaches the method of claim 27, further comprising: "saving the at least one object" at Col. 7 lines 25-50.

As per claim 31, teaches the method of claim 27, further comprising: "re-executing the work flow by traversing the at least one object" at Col. 8 lines 50-62.

As per claim 32, Unger teaches the method of claim 27, further comprising: "creating a new work flow by modifying the at least one object" at Col. 8 lines 50-62.

As per claim 33, Unger teaches the method of claim 21, further comprising: "annotating at least one of the first group, third group, or any portion of any document contained in the first group or the third group" at Col. 4 lines 50-57.

As per claim 34, Unger teaches the method of claim 21, wherein the initial group of documents is from at least one of a database, an external source, or the Internet" at Col. 4 lines 1-2.

Claims 35-90 recite a method, system, computer program product, and a device for performing similar method as in claims 21-34. Claims 35-90 are therefore rejected by the same reasons discussed above.

Response to Arguments

6.   Applicant's arguments filed September 29, 2006 have been fully considered but they are not persuasive. The examiner respectfully traverses applicant's arguments.

Regarding the §101 rejection to claims 77-90, applicants argued that the term "logic" as recited in claims 77-90 is not limited to software, but also cover hardware. The

examiner respectfully submits that nowhere does applicant's specification discloses the

claimed "logic" is hardware, but instead defines logic as "computer software" at [0044]

and "computer programs" at [0049]. Specifically, applicant's specification provides:

"The primary memory 508 has stored therein control **logic** 510 (**computer**

software), and data 512" at [0044]

"**Computer program** (also called computer control **logic**) are stored in main

memory 508 and/or the secondary storage devices 514" at [0049].

In view of applicant's specification, the claimed device is therefore comprises

only software components and therefore rejected as being intangibly embodied.

In response to applicants' argument that Unger does not teach or suggest

"selectively iterating includes performing an additional iteration of the searching using

the fourth group as input, to output a fifth group of documents", the examiner

respectfully submits that Unger teaches at Col. 6 lines 45-55 the step of using "patent

numbers for this set of patents" (i.e., "the fourth group") as unique identifiers to search

and display the full text and associated graphic images (i.e., "output a fifth group of

document".)

In light of the foregoing arguments, the 35 U.S.C 101 and 102 rejections are

hereby sustained.

Conclusion

7.   The prior art made of record, listed on form PTO-892, and not relied upon, if any, is considered pertinent to applicant's disclosure.

If a reference indicated as being mailed on PTO-FORM 892 has not been enclosed in this action, please contact Lisa Craney whose telephone number is **(571) 272-3574** for faster service.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh B. Pham whose telephone number is (571) 272-4116. The examiner can normally be reached on Monday through Friday 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic · Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative.or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Khanh B. Pham
Examiner
Art Unit 2166

November 6, 2006